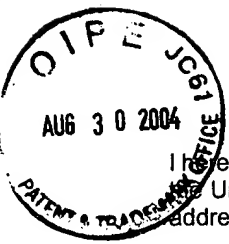


AF/3747 IFW



CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: August 26, 2004

JANET FARR
(Type or print name of person mailing paper)
Janet Farr
(Signature of person mailing paper)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket No. 3043R **PATENT**

In re Appellant:

Chamberlin III, et al.	:	
	:	
Serial No: 09/727,622	:	Art Unit: 3747
	:	
Filed: December 01, 2000	:	Examiner: Hai H. Huynh

For: METHOD OF OPERATING AN INTERNAL COMBUSTION ENGINE

REPLY BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

This Reply Brief is submitted, in triplicate, in the above-identified application in response to the Examiner's Answer mailed August 06, 2004, for which a two-month period for reply is provided by 37 CFR 1.193. Accordingly, Appellant's Reply Brief is timely filed.

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APPELLANT'S RESPONSE TO EXAMINER'S ANSWER

Appellant incorporates herein by reference, as if fully restated, all of the statements of fact, arguments and points of law set forth in Appellant's Appeal Brief.

In responding to Appellant's statements of fact, arguments and points of law in the Appeal Brief, the Examiner merely contends:

The crux of Appellant's argument at pages 4-12 of the Appeal Brief is regarding the motivation to combine prior art references. Manka et al (5,834,407) suggest, "the lubricating compositions may be lubricating oils and greases useful in industrial applications and in automotive engines, transmissions and axles. These lubricating compositions are effective in a variety of applications including crankcase lubricating oils for spark-ignited, and compression-ignited internal combustion engines, including automobile and truck engines, two-cycle engines, aviation piston engines, marine and low-load diesel engines, and the like. Also automatic transmission fluids, farm tractor fluids, transaxle lubricants, gear lubricants, metalworking lubricants, hydraulic fluids, and other lubricating oil and grease compositions can benefit from the incorporation of the compositions of this invention (see col. 27 lines 8-31)." Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the lubricating compositions that has low phosphorus on the camless engine of Schechter as taught by Manka et al in order to reduce wear on the contacting surfaces of the engine components.

Applicant respectfully submits that this rationalization fails to rise to the level required to support a rejection for obviousness. To the extent the above-quoted disclosure provides any motivation, it is such a general motivation that it cannot possibly support the contention that Appellant's invention would have been obvious. It is simply not sufficiently specific to support the contention that Appellant's claimed invention would have been obvious. As noted in the Appeal Brief, Manka et al. includes nothing to suggest that the low phosphorus lubricant disclosed therein would be any more useful in a camless engine than would any other lubricant. Camless engines are not mentioned by Manka et al., although many other types of engines and possible applications are listed.

First, there is nothing in the above-quoted disclosure to direct a person to camless engines, and the Examiner has identified none. The above-quoted disclosure from Manka et al. therefore constitutes no more than an invitation to experiment, not a suggestion to apply the lubricating compositions of Manka et al. to a specific engine type not even identified in the list disclosed in Manka et al. There is nothing in Manka et al. that would have led a person of ordinary skill in the art to the camless engines of Schechter. Similarly, there is nothing in Schechter that would have led the person to select the lubricant of Manka et al. from all possible lubricants. Absent any such teaching or suggestion in the references, the asserted combination can only have resulted from the improper application of hindsight reconstruction of Appellant's invention.

Second, the list disclosed by Manka et al. is so broad as to cover virtually any possible application, once again constituting nothing more than an invitation to experiment.

Third, the above-quoted disclosure of Manka et al. is taken out of context. The above-quoted disclosure refers generally to the compositions disclosed and claimed in Manka et al., of which all embodiments include phosphorus, but only some embodiments include the presently claimed phosphorus level which "does not exceed about 0.08% by weight" and no embodiment in which the composition is phosphorus-free. See Manka et al. col. 28, lines 49-60. Here again, there is no more than an invitation to experiment.

It is well known, long-standing patent law that a mere "invitation to experiment" or, at best, an "obvious to try" situation, does not meet the standard required for an obviousness rejection. "Obvious to try" has long been held not to constitute obviousness. *In re O'Farrell*, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. *It might be obvious to try the lubricant of Manka et al. in a camless engine, but it is no more obvious to try the Manka et al. lubricant than it would be to try any known lubricant.* The Examiner failed to make any greater showing that this, and this simply cannot have resulted in the obviousness of Appellant's claimed invention.

The general desire to reduce phosphorus, evidenced by Manka et al., runs contrary to the long-held belief that phosphorus, e.g., in the form of zinc dithiophosphate, is a

needed and necessary ingredient in lubricating oils for passenger car engines. Efforts have been made to reduce phosphorus while maintaining the requisite lubrication, as evidenced by the invention of Manka et al. However, a general desire does not beget more than an obvious to try situation, and that is an insufficient basis upon which a case of obviousness may be predicated.

“Obvious to try” does not mean there is necessarily a “reasonable expectation of success”. The Examiner must show a reasonable expectation of success in making the asserted combination, assuming that the motivation to make the asserted combination has been shown.

Obviousness requires one of ordinary skill in the art have a reasonable expectation of success as to the invention—“obvious to try” and “absolute predictability” are incorrect standards. *Id.* Having shown no more than that the contended combination of Manka et al. with Schechter could be made, and failing to have shown a proper motivation to have made the combination, the combination rises to no more than the “obvious to try” level. Accordingly, Appellant respectfully submits that the Examiner failed to show any motivation, and has failed to show a reasonable expectation of success.

The Examiner provided no facts or evidence in support of a reasonable expectation of success. In addition to the requirements of showing all the limitations of the claimed invention and showing a motivation to have made the contended selection and combination, in order to state a legally correct case of *prima facie* obviousness, the Examiner must show some evidence of a reasonable expectation of success. In the present case, the Examiner failed to make any such showing. The only motivation shown by the Examiner is the general motivation to use virtually any lubricant in any device in which a lubricant is needed. This is such a general motivation that it cannot possibly support the contention that Appellant’s invention would have been obvious. Where there is no motivation, there can be no reasonable expectation of success.

The lack of reasonable expectation of success is particularly pertinent with respect to a developing technology such as the camless engine. Those developing the camless engine, such as Schechter, are faced with an entire universe of possibly suitable lubricants

to choose from. One might just as well expect that a wholly new type of lubricant would be needed, due to the significant differences between a camless engine and a traditional "cammed" internal combustion engine, as to expect that any particular lubricant would be preferred. There is simply nothing that would suggest that a low-phosphorus lubricant, such as that of Manka et al. would be any more useful to the camless engine than would *any* lubricant.

Accordingly, Appellant respectfully submits that the Examiner has shown neither a proper motivation nor a reasonable expectation of success in making the contended combination of references. Having failed to establish two of the three requisite factors to establish a *prima facie* case of obviousness, the rejections of Appellant's claims cannot stand, and should be reversed. As pointed out in the Appeal Brief, the Examiner failed to rebut Appellants' arguments as to reasonable expectation of success. For this additional reason, the rejection of Appellant's claims is erroneous and should be reversed.

Finally, in the Examiner's Answer, the Examiner essentially restated his original rejection and, in responding to Appellant's arguments, did nothing more than copy a disclosure from Manka et al. and then state, again in wholly conclusory fashion, that it would have been obvious to make the contended combination. The Examiner failed to provide any logical connection between the quoted disclosure and his conclusion that the contended combination would have rendered obvious Appellant's claimed invention. This statement provides essentially no basis for review by the Board or by the courts, and provides scant basis for Appellant's rebuttal.

Accordingly, Appellant respectfully requests the Board to reverse the Examiner's rejections.

CONCLUSION

For all these reasons, as well as the reasons set forth in the Appeal Brief and in the previously submitted responses to Office Actions prior to the Appeal, Appellant respectfully submits that the rejection of Appellant's claims 1, 3-9 and 13-31 under 35 U.S.C. §103(a) should be reversed because the asserted combination of references would not have

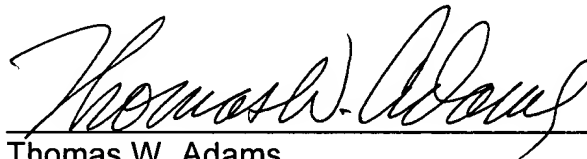
rendered obvious Appellants' claimed invention at the time the invention was made. Appellants respectfully request reversal of the Examiner's rejections of Appellants' claimed invention under Section 103(a).

In the event issues remain in the prosecution of this application, Appellants request that the Examiner telephone either undersigned attorney to expedite consideration and/or allowance of the application.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR

Date: August 26, 2004

A handwritten signature in cursive script, appearing to read "Thomas W. Adams", written over a horizontal line.

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